

REMARKS

This patent application contains claims 1-44, all of which stand rejected. On January 31, 2008, the applicants submitted a declaration swearing behind the primary reference, Published US Patent Application No. 2005/0105508. The examiner has now finally rejected all of the claims, holding that the declaration does not present sufficient facts to establish conception of the invention and refusing to consider it. All rejections are respectfully traversed.

The examiner offers no authority for the refusal to consider the declaration, other than to state that:

While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another.

Even if it were assumed, for the purposes of argument, that the examiner has recited the correct standard for accepting the declaration, he has reached the wrong conclusion. Clearly, the invention disclosure was submitted by the inventor to another and, as shown below, was sufficient for the corporate reviewer and patent counsel to understand and conclude that a patent application should be filed.

Apparently, the examiner does not understand the nature of the exhibits attached to the declaration. In paragraph 3 of the declaration, the inventor explains that he "submitted documentation to general counsel for ITXC Corp. containing the details of the conception of my invention." The first four pages of the exhibit constitute a chain of e-mails demonstrating that the inventor submitted an invention disclosure form to the general counsel of ITXC Corp., Mr. Weitz, on October 15, 2003 requesting consideration of his invention. The remaining pages of the exhibit are a copy of that form.

In the e-mails, Mr. Weitz confirms receiving the disclosure. Subsequently, the inventor sent an mail asking Mr. Weitz if anything further was needed, and Mr. Weitz responded that he had sent to the disclosure to patent counsel. The procedure reflected by the e-mails is very common in industry, where forms are filled in to receive disclosures from inventors, evaluated (by an assigned officer or committee), and sent on to patent counsel if applying for a patent is

deemed warranted. Furthermore, the examiner knows that the present patent application was actually filed in February 2004.

In the last response, it was demonstrated in detail that relevant subject matter of the claims is, in fact, present in the "Intervention Disclosure Form" (IDF) that the inventor submitted. Clearly, it is the form used by the company, and the inventor answered the pertinent questions as he considered appropriate. It is unfortunate that the disclosure is not in a form and that the examiner would like, but it is a form that the company considered appropriate to use, and that should be of no consequence. Furthermore, the corporation counsel understood the disclosure well enough to realize that it should be sent to patent counsel for the preparation of a patent application, and patent counsel understood it well enough actually to prepare the application.

It is noted that the IDF describes the problem involved in the invention in paragraphs 2 and 3. This essentially tracks the disclosure of the present application. In paragraph 4, the inventor describes what he changed. Specifically, he refers to a command which runs an application to measure a call's up time and release calls that are over 180 minutes. So, there can be no doubt that the inventor disclosed this concept. Moreover, this explanation must be considered in the context of what the inventor explained in paragraph 3 about the existing ITXC systems. No doubt, the person evaluating the disclosure would have knowledge of and consider existing systems of the company in evaluating the invention.

It is noted that the examiner is not objecting to the quality of the disclosure in the patent application, which would be appropriate, if it were somehow inadequate. He is objecting to the quality of the disclosure made by the inventor to the corporation and patent counsel! Respectfully, this is none of his business. The company uses disclosure forms that it has found effective and the inventor completed one and submitted it in accordance with company procedures. The reviewer, corporate counsel, understood it and passed it on to a patent attorney for preparation of an application. Moreover, it has been demonstrated that the claims in this application, in fact, incorporate the subject matter of the disclosure. Logically, how could the inventor not have conceived of the invention within the invention disclosure form?

If the examiner has legal authority for his approach for refusing to consider the declaration, he should cite it. As explained in the last response, for conception to be complete

"the invention must be ready for patenting." In the present instance, both the corporate reviewer and patent counsel concluded, on the basis of the submitted invention disclosure, that the invention was ready for patenting. The examiner's rationale for refusing to consider the declaration flies in the face of how knowledgeable reviewers viewed the disclosure and ignores the fact that it actually resulted in a patent application.

It is respectfully submitted that the examiner may not substitute his judgment of the quality of the invention disclosure for the judgment of those who actually received and reviewed it at that time and decided it disclosed an invention worthy of a patent application.

We cited *Pfaff v. Wells Elec.*, 525 U.S. 55 in our last response for the proposition that an invention is complete when it is "ready for patenting." That is *all* for which it was cited, and it should be clear that the examiner can not cite it for any proposition related to the quality of a disclosure necessary to establish conception. In that case, the invention had been found to have been barred owing to a public use. The nature of the public disclosure was a key issue, so the court had to why the acts that were taken constituted a public disclosure. We have no such issue in the present case. The understanding of the invention that the public would have from the IDF is of no consequence. The *only* relevant information is that knowledgeable reviewers found the IDF to contain disclosure warranting a patent application and that the disclosed information appears in the application.

In summary, the record shows that the inventor submitted an IDF approved by the company prior to the critical date; that the corporate reviewer understood it sufficiently to submit it to patent counsel for the preparation of a patent application; that patent counsel actually prepared the application; and that key disclosures in the IDF appear in the claims. Respectfully, under these circumstances, it is inconceivable how the examiner could not conclude that the applicant has not established prior conception.

The examiner's repeated copying of some 25 pages of claim rejections (without change) is unwarranted, and it stands in stark contrast to the short shrift that the declaration has been given. For some 20 months, the declaration has been the only issue in this application, yet the examiner has hardly gone beyond the hand waving stage. If he persists in this rejection he should explain specifically why the submitted declaration is inadequate when it shows that the inventor did disclose the invention to others who understood it and that he, in fact, followed

corporate procedures which resulted in a filing. The invention was not only “ready for patenting”, but prior to the critical date, the inventor put into motion the process that resulted in the application being actually filed. It should not be necessary to file an appeal to get reasonable consideration of the declaration.

For the above reasons, it is requested that the examiner study the declaration and attached exhibits while carefully, reconsider is refusal to accept the declaration, and withdraw all current rejections, as they are based on a reference which does not qualify legally as prior art.

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Respectfully submitted,

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